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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,109

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Pascal Fourcade

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EXAMINER

LENIHAN, JEFFREY S

ART UNIT

PAPER NUMBER

1765

MAIL DATE

DELIVERY MODE

12/02/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,109	Applicant(s) FOURCADE, PASCAL	
	Examiner Jeffrey Lenihan	Art Unit 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15, 17-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15, 17-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the amendment filed on 9/24/2010 and the supplemental amendment filed on 8/5/2011.
2. The objections and rejections not addressed below are deemed withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the [fifth paragraph of 35 U.S.C. 112], a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

5. Claim 28 is rejected under 35 U.S.C. 112, 4th paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends. As amended, independent claim 8 states that one of the claimed polymer components must be present in an amount greater than 50% by weight. Claim 28, however, states that the two polymer components are each present in an amount of 50%; neither component is present in an amount greater than 50% as required by the parent claim. Claim 28 therefore impermissibly broadens the scope of the parent claim rather than further limiting it. Applicant may cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, rewrite the claim(s) in independent form, or present

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a sufficient showing that the dependent claim(s) complies with the statutory requirements.

Claim Rejections - 35 USC § 103

6. Claims 8-15, 17-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nabeta et al, US4302554 (of record), in view of Marechal, EP1312624 (of record).

7. The rejection stands as per the reasons outlined in the previous Office Action, incorporated herein by reference (for claims 8-15, 17-21 and 23-27).

8. For claim 28: As discussed in previous Office Actions, Nabeta discloses a composition comprising an olefinic copolymer and a styrene/butadiene block copolymer having a styrene content in the range of 50 to 90%. Said olefinic copolymer may be present in an amount up to 50% by weight (Column 3, lines 22-24). Said styrene/butadiene block copolymer may be present in an amount up to 70% by weight (Column 3, lines 4-11). It has been held that in the case where the claimed ranges overlap or lie inside ranges disclosed in the prior art, a *prima facie* case of obviousness exists; see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (MPEP § 2144.05). The prior art ranges both contain the claimed value of 50% by weight; barring a showing of evidence demonstrating unexpected results, it therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the claimed invention in view of the teachings of Nabeta.

9. Claims 8-15, 17-19, 24, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al, WO 01/15897 (of record), in view of Marechal, EP1312624 (of record).

The rejection stands as per the reasons outlined in the previous Office Action, incorporated herein by reference.

Response to Arguments

10. Applicant's arguments, see pages 7-9, filed 4/8/2011, with respect to the rejections of claims 8-15, 17, 18, 24-27 over Wilkie in view of secondary references have been fully considered and are persuasive. The rejections have been withdrawn.

11. Applicant's arguments filed 4/28/2011 have been fully considered but they are not persuasive with respect to the rejection of claims over Nabeta or Ishii.

12. Regarding the rejection of claims over Nabeta: Applicant argues that because Nabeta does not disclose a desire for improved extrusion stability, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of Nabeta as discussed in the previous Office Actions. Obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art; see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992); and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). Furthermore, in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004), the court rejected the notion that an express written motivation to combine must appear in prior art references (MPEP § 2143.01[R-5] (I)). In this case, as discussed in the previous Office Actions, Marechal teaches that the use of a bridged metallocene catalyst results in polymers that are characterized by improved extrusion stability. In view of the general knowledge available at the time the invention was made, it therefore would have been obvious to one of ordinary skill in the art to modify the composition of Nabeta by using a bridged metallocene catalyst to prepare the olefinic polymer, corresponding to the claimed metallocene-catalyzed ethylene polymer, in order to obtain the improved properties of extrusion stability taught by Marechal.

13. Regarding applicant's argument that one of ordinary skill must be motivated by the same general problem as the inventor: The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant; see *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (MPEP § 2144). Contrary to applicant's argument, *In re Kahn* does not require that the motivation to modify the prior art must be directed towards the same problem as that facing the inventors. Also, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for

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patentability when the differences would otherwise be obvious; see *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. App. Inter. 1985). It is therefore insufficient to argue that the prior art does not teach the proposed modification in order to obtain the same result disclosed by applicant.

14. Regarding the allegedly unexpected results: Both independent claims require that one of the claimed components is present in an amount greater than 50% by weight. The sole example provided in the specification discloses a composition which is a 50/50 blend of the polymer components. As neither polymer is present in an amount greater than 50%, the composition disclosed in the example does not fall within the scope of the invention recited in the independent claims. The allegedly unexpected results therefore are not pertinent to the patentability of the claimed invention.

15. Regarding the rejection of claims over Ishii: As discussed in the previous Office Actions, incorporated herein by reference, Ishii discloses a composition comprising 5 to 50% by weight of a styrene/butadiene block copolymer and 5 to 50% by weight of a metallocene-catalyzed ethylene/olefin copolymer, corresponding to the claimed polymer components. It has been held that a *prima facie* case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corp. of America v. Banner* 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). The claimed range “greater than 50 wt. %” reads on values that are only slightly greater than 50%-for example, 50.1%. Because the claimed invention reads on embodiments wherein the difference between the claimed invention and the prior art is so small, one

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of ordinary skill in the art would reasonably expect that the properties of films within the scope of the claimed invention would not be materially different from those of the prior art composition comprising up to 50% of either a styrene/butadiene block copolymer or metallocene-catalyzed ethylene copolymer. The burden is therefore shifted to applicant to provide evidence demonstrating that the unexpected results are obtained from the invention as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Irina S Zemel/
Primary Examiner, Art Unit 1765

/Jeffrey Lenihan/
Examiner, Art Unit 1765

/JL/